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Remarks

Claims 27, 35, 43 and 47 have been amended. Claims 44-46 have been withdrawn. New claims 51-53 have been added. Support for the amendments to claims 27, 35, 43 and 47 can be found in general throughout Applicant's Specification and in particular, for example, at page 8, lines 13-14. Claim 43 has been amended to correct clerical errors and not for reasons related to patentability. No new matter has been added.

The amendments to claims 27, 35 and 47 have been made to further clarify the nature of the dust reducing additive, to make that which was implicit explicit, and not for reasons related to patentability. Applicant respectfully requests entry of this Amendment. The July 26, 2005 Office action takes the position that water is a dust reducing additive. However, to the extent water is present in or added to a joint compound, the water necessarily evaporates as the joint compound hardens. The reduction in the amount of dust generated by a joint compound is determined by sanding a hardened joint compound. Given the nature of water and the fact that water is not present in a hardened joint compound, water is not a dust reducing additive. Therefore, claim 27, as previously pending, implicitly excluded water from the definition of the term "dust reducing additive." The amendment to claim 27 thus expressly states that which was previously implicit in the claim. For at least these reasons, Applicant respectfully requests entry of this Amendment.

Applicant thanks the Examiner for kindly indicating that claims 39-42 would be allowable if rewritten in independent form. Applicant has done this in the form of new claims 51-53. An indication as to the allowability of the same is respectfully requested.

Applicant also thanks the Examiner for his helpful reminder regarding the election made in the parent application as it pertains to previously submitted claims 44-46, now withdrawn.

Claims 35, 43, and 47-50 stand rejected under 35 U.S.C. § 102(b) over Williams (U.S. 4,454,267), Struss et al. (U.S. 4,686,253), Patel (U.S. 5,653,797) or Smith et al (U.S. 4,286,995).

Williams discloses a joint compound that includes filler, binder, treated expanded perlite, a non-leveling agent, and a thickening agent.

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Struss et al. disclose a joint compound that includes a filler, a binder, a non-leveling and slip providing material, a water retention or thickening agent, and expanded perlite particles that have been treated to make them water repellent.

Patel discloses a process for preparing ready-mixed setting-type joint compound that includes calcium sulfate hemihydrate, water, and a set retarding agent.

Smith et al. disclose a joint compound that includes gypsum crystals formed by the hydration of calcium sulfate to calcium sulfate dihydrate. The crystals can form in the presence of citric acid.

Claim 35 is directed to a method of reducing the quantity of dust generated by a drywall joint compound that includes filler, water, defoamer, wetting agent, preservative, fungicide, thickener, non-leveling agent, surfactant, solvent and binder. The method includes adding a sufficient quantity of dust reducing additive to the drywall joint compound to reduce the quantity of dust generated by sanding the hardened drywall joint compound, and the adding occurs subsequent to the filler, water, defoamer, wetting agent, preservative, fungicide, thickener, nonleveling agent, surfactant, solvent and binder being present in the joint compound. Claim 35 further specifies that if the dust reducing additive includes a solvent, the solvent evaporates at a rate slower than water. Under 35 U.S.C. § 102(b), the subject matter of a claim is anticipated if each and every element set forth in the claim is found in the a single prior art reference. *Verdegaal Bros., Inc., v. Union Oil Co.*, 814 F.2d 628, 631 (Fed. Cir. 1987). If the reference fails to teach even one limitation of the claimed invention, then the claim is not anticipated under § 102(b). *Atlas Powder Co. v. E.I. du Pont De Nemours & Co.*, 750 F.2d 1569, 1574 (Fed. Cir. 1984). It is undisputed that neither Williams nor Struss et al. nor Patel nor Smith et al. teach adding a dust reducing additive to a drywall joint compound that includes filler, water, defoamer, wetting agent, preservative, fungicide, thickener, non-leveling agent, surfactant, solvent and binder, wherein if the dust reducing additive includes a solvent, the solvent evaporates at a rate slower than water. The July 26th Office action takes the position that water is a dust reducing additive. Water is not a dust reducing additive in a hardened joint compound. In addition, claim 35, as amended, excludes water as a dust reducing additive, i.e., it is axiomatic that water cannot evaporate slower than water. The cited references thus lack a required element of claim

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35. Applicant submits, therefore, that the rejection of claim 35 under 35 U.S.C. § 102(b) over Williams, Struss et al., Patel or Smith et al. has been overcome and request that it be withdrawn.

Claims 47-49 are distinguishable under 35 U.S.C. § 102(b) over Williams, Struss et al., Patel or Smith et al. for at least the same reasons set forth above in distinguishing claim 35.

Claim 43 is directed to a method of reducing the quantity of dust generated by a drywall joint compound that includes filler, water, thickener, non-leveling agent, and binder. The method of claim 43 includes adding a dust reducing additive selected from the group consisting of oils, glycols, waxes, paraffins, terpenes, and combinations thereof, to the drywall joint compound in an amount sufficient to reduce the quantity of dust generated by sanding the resulting drywall joint compound, when hardened, relative to the quantity of dust generated by the hardened drywall joint compound in the absence of the dust reducing additive. Williams does not even mention oil, glycol, wax, paraffin or terpene. Therefore, Williams cannot teach each and every element of the method of claim 43. Nothing in the record establishes anything to the contrary. Accordingly, a *prima facie* case of anticipation of claim 43 in view of Williams has not been made. Applicant requests, therefore, that the rejection of claim 43 under 35 U.S.C. § 102(b) over Williams be withdrawn. Should this rejection be maintained, Applicant respectfully requests that the next action indicate, by reference to column and line number, the location of the requisite teaching in Williams.

Struss et al. do not teach glycols, waxes, paraffins, and terpenes. To the extent that Struss et al. mention oils, they do not teach adding oil to a dry wall joint compound that includes filler, water, thickener, non-leveling agent, and binder. Thus Struss et al. fail to teach each and every element of the method of claim 43. The July 26th Office action indicates that water is a dust reducing additive. However, water is not an oil, a glycol, a wax, a paraffin or a terpene. Accordingly, the record fails to establish a *prima facie* case of anticipation of claim 43 in view of Struss et al. Applicant submits, therefore, that the rejection of claim 43 under 35 U.S.C. § 102(b) over Struss et al. is unwarranted and must be withdrawn. Should this rejection be maintained, Applicant

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respectfully requests that the next action indicate, by reference to column and line number, the location of the requisite teaching in Struss et al.

Patel does not teach adding a dust reducing additive selected from the group consisting of oils, glycols, waxes, paraffins, terpenes, and combinations thereof to a drywall joint compound that includes filler, water, thickener, non-leveling agent, and binder. The July 26th Office action indicates that water is a dust reducing additive. However, water is not an oil, a glycol, a wax, a paraffin or a terpene. Thus the record does not establish a *prima facie* case of anticipation of claim 43 in view of Patel. Applicant submits, therefore, that the rejection of claim 43 under 35 U.S.C. § 102(b) over Patel is unwarranted and requests that it be withdrawn. Should this rejection be maintained, Applicant respectfully requests that the next action indicate, by reference to column and line number, the location of the requisite teaching in Patel.

Waxes, paraffins, and terpenes are not mentioned in Smith et al. In addition, Smith et al. do not teach adding a dust reducing additive selected from the group consisting of oils and glycols to a drywall joint compound that includes filler, water, thickener, non-leveling agent, and binder. Nothing in the record establishes anything to the contrary. The July 26th Office action indicates that water is a dust reducing additive. However, water is not an oil, a glycol, a wax, a paraffin or a terpene. Accordingly, a *prima facie* case of anticipation of claim 43 in view of Smith et al. has not been established. Applicant submits, therefore, that the rejection of claim 43 under 35 U.S.C. § 102(b) over Smith et al. cannot stand and requests that it be withdrawn.

Claim 50 is directed to a method of making a low dust generating drywall joint compound where the method includes combining components that include filler, water, thickener, binder, and from 1.5 % by weight to 6 % by weight of a dust reducing additive that includes at least one glycol, oil, wax, paraffin, terpene or surfactant, and mixing the components. Williams does not even mention oil, glycol, wax, paraffin, terpene or surfactant. Williams also does not teach a joint compound that includes from 1.5 % by weight to 6 % by weight of a dust reducing additive that includes at least one glycol, oil, wax, paraffin, terpene or surfactant. In addition, none of the example compositions of Williams includes glycol, oil, wax, paraffin, terpene or surfactant. Therefore Williams cannot be deemed to teach a composition that includes from 1.5 % by weight to 6 % by

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weight of a dust reducing additive that includes at least one glycol, oil, wax, paraffin, terpene or surfactant. A *prima facie* case of anticipation of claim 50 in view of Williams thus has not been established. Applicant respectfully requests that the rejection of claim 50 under 35 U.S.C. § 102(b) over Williams be withdrawn. Should this rejection be maintained, Applicant respectfully requests that the next action indicate, by reference to column and line number, the location of the requisite teaching in Williams.

Struss et al. also fail to teach the method of claim 50. Nowhere in Struss et al. is there a mention of glycol, wax, paraffin or terpene. In addition, none of the example compositions of Struss et al. include glycol, wax, paraffin, or terpene. To the extent that any oil or surfactant resulting from the "treating agent" referred to at column 6, lines 48-53 of Struss et al. is present in the compositions of Examples 4-10 of Struss et al., the amount of oil or surfactant is necessarily less than 1.5 % by weight. Therefore, the compositions of the examples of Struss et al. do not include from 1.5 % by weight to 6 % by weight of at least one glycol, oil, wax, paraffin, terpene or surfactant. Accordingly a *prima facie* case of anticipation of claim 50 in view of Struss et al has not been established. Applicant respectfully requests that the rejection of claim 50 under 35 U.S.C. § 102(b) over Struss et al. be withdrawn. Should this rejection be maintained, Applicant respectfully requests that the next action indicate, by reference to column and line number, the location of the requisite teaching in Struss et al.

Patel also does not expressly or inherently teach the method of claim 50. Patel does not mention wax, paraffin or terpene, and none of the compositions of the Examples of Patel include wax, paraffin or terpene. Patel also does not teach including from 1.5 % by weight to 6 % by weight at least one glycol, oil, or surfactant in a drywall joint compound. The compositions of Examples 1 and 4-6 of Patel include glycol; however the amount of glycol is less than 1.5 %. To the extent the compositions of Examples 1-6 include any oil or surfactant, the amount is necessarily less than 1.5 % by weight. Nothing in the record establishes anything to the contrary. Accordingly a *prima facie* case of anticipation of claim 50 in view of Patel has not been established. Applicant respectfully requests, therefore, that the rejection of claim 50 under 35 U.S.C. § 102(b) over Patel be withdrawn. Should this rejection be maintained, Applicant respectfully

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requests that the next action indicate, by reference to column and line number, the location of the requisite teaching in Patel.

Smith et al. also do not expressly or inherently teach the method of claim 50. Wax, terpene and paraffin are not mentioned anywhere in the Smith et al. patent. Smith et al. disclose one example composition and that composition does not include wax, terpene or paraffin. Although the composition of Smith et al. includes glycol and oil defoamer, the amounts thereof are less than 1.5 % by weight. Smith et al. thus fail to teach at least one required element of claim 50. Accordingly a *prima facie* case of anticipation of claim 50 in view of Smith et al. has not been established. Therefore, Applicant respectfully requests that the rejection of claim 50 under 35 U.S.C. § 102(b) over Smith et al. be withdrawn. Should this rejection be maintained, Applicant respectfully requests that the next action indicate, by reference to column and line number, the location of the requisite teaching in Smith et al.

Claims 27, 28 and 36-38 stand rejected under 35 U.S.C. § 102(b) or, in the alternative, under 35 U.S.C. § 103 over Williams, Struss et al., Patel or Smith et al.

The descriptions of Williams, Struss et al., Patel and Smith et al. set forth above are incorporated herein.

Claim 27 is directed to a method of reducing the quantity of dust generated by a drywall joint compound, where the method includes providing a drywall joint compound that includes filler, water, binder, and at least one of a defoamer, wetting agent, preservative, fungicide, thickener, non-leveling agent, surfactant, and solvent, and subsequently adding a sufficient quantity of dust reducing additive to the drywall joint compound to reduce the quantity of dust generated by sanding the hardened drywall joint compound by at least 50 %, wherein if the dust reducing additive includes a solvent, the solvent evaporates at a rate slower than water. For anticipation to exist, the cited reference must teach each and every element of the claim. Neither Williams nor Struss et al. nor Patel nor Smith et al. teach adding a dust reducing additive to a drywall joint compound that includes filler, water, binder and at least one of defoamer, wetting agent, preservative, fungicide, thickener, non-leveling agent, surfactant, and solvent, wherein if the dust reducing additive includes a solvent, the solvent evaporates at a rate slower than water, as required by claim 27. The positions set forth in Applicant's June 6, 2005

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Amendment with respect to claim 27 and Williams, Struss et al., Patel and Smith et al. are incorporated herein by reference.

The July 26th Office action takes the position that water is a dust reducing additive. As set forth above, water is not a dust reducing additive in a hardened drywall joint compound. Williams, Struss et al., Patel or Smith et al. do not teach that water reduces the quantity of dust generated by sanding their hardened dry wall joint compounds. Moreover, it is not the case that water would inherently be present in the hardened compounds of Williams, Struss et al., Patel or Smith et al. Rather, water evaporates as the compound hardens. Because water is not present in the hardened compound it cannot impact the compound. Therefore water cannot inherently reduce the amount of dust generated by sanding the hardened compounds of Williams, Struss et al., Patel or Smith et al. Moreover, claim 27 has been amended to expressly exclude water as a dust reducing additive, i.e., it is axiomatic that water cannot evaporate slower than water. Williams, Struss et al., Patel and Smith et al. thus fail to teach a required element of the method of claim 27. Applicant submits, therefore, that the rejection of claim 27 under 35 U.S.C. § 102(b) over Williams, Struss et al., Patel or Smith et al. is unwarranted and requests that it be withdrawn.

Williams, Struss et al., Patel and Smith et al. also do not suggest the method of claim 27. To establish a *prima facie* case of obviousness based upon a proposed combination of references there must be a teaching, suggestion or motivation in the prior art for making the proposed combination. See M.P.E.P. 2142; *Fromson v. Anitec Printing Plates, Inc.*, 132 F.3d 1437 (Fed. Cir. 1997); *C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1352, (Fed. Cir. 1998). The suggestion or motivation to make the claimed combination must be found in the prior art and must not be based on Applicant's disclosure. See M.P.E.P. 2142. Here there is no such teaching, suggestion or motivation. Neither Williams, Struss et al., Patel or Smith et al. suggest subsequently adding a dust reducing additive to a drywall joint compound that includes filler, water, binder and at least one of a defoamer, wetting agent, preservative, fungicide, thickener, non-leveling agent, surfactant, and solvent, wherein if the dust reducing additive includes a solvent, the solvent evaporates at a rate slower than water. Nothing in the record establishes anything to the contrary. Moreover, the skilled artisan would have no reason to modify

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Williams, Struss et al., Patel or Smith et al. so as to achieve the method of claim 27. Applicant submits, therefore, that the rejections of claim 27 under 35 U.S.C. § 103 over Williams, Struss et al., Patel or Smith et al. have been overcome and request that they be withdrawn.

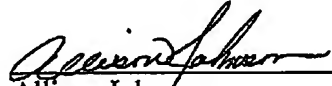
Claims 28 and 36-38 are distinguishable under 35 U.S.C. § 102(b) or § 103 over Williams, Struss et al., Patel or Smith et al. for at least the same reasons set forth above in distinguishing claim 27.

The claims now pending in the application being in condition for allowance, such action is respectfully requested. Should the next action be other than a Notice of Allowance, a teleconference interview is respectfully requested.

The Commissioner is hereby authorized to charge any additional fees that may be required and to credit any overpayment to Deposit Account No. 501,171.

Respectfully submitted,

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